

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/711,550
Applicant: MCMONAGLE et al.
Filed: September 24, 2004
Docket No.: 030848-000026
Title: CENTRALIZED CHECK IMAGE
STORAGE SYSTEM

Confirmation No. 5549

MAIL STOP PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENT THAT ALL
INVENTORS SIGN A DECLARATION UNDER 37 C.F.R. § 1.131**

This paper is being filed in association with a Declaration under 37 C.F.R. § 1.131 requesting that the requirement for the signature of inventor Douglas G. Smith be waived, since inventor Douglas G. Smith has refused to cooperate in making the Declaration. The appropriate petition fee is included herewith.

Details of Efforts to Obtain Signature by the Nonsigning Inventor

I, Steven B. Phillips, made a diligent effort to get Mr. Smith to cooperate in making the Section 131 Declaration. On September 19, 2008, I emailed a copy of the Declaration to Mr. Smith, requesting his review and signature. Mr. Smith responded on September 20, 2008, expressing reluctance to sign the Declaration due to liability concerns and a "give a darn" level being "very, very low." I sent follow-up Emails to Mr. Smith on September 23, 2008 and October 13, 2008. Each of these Emails received no response. Copies of the referenced Emails are attached hereto. On the morning of February 9, 2008, I called Mr. Smith at the telephone number he provided and my call was routed to a voicemail box with a personal greeting for "Doug and Betsy Smith." I left a message requesting that Mr. Smith call me back as soon as possible regarding the Declaration under Section 131, and as of this writing, I have not received a return call from Mr. Smith.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date: 9 Feb 2009

Telephone: (919) 286-8000
Facsimile: (919) 286-8199



Steven B. Phillips
Attorney for Applicants
Registration No. 37,911
Moore & Van Allen PLLC
P.O. Box 13706
Research Triangle Park, NC 27709

Steven Phillips

From: Steven Phillips
Sent: Monday, October 13, 2008 11:37 AM
To: 'Doug'
Subject: RE: Viewpointe Declaration of Prior Conception and Due Diligence

Hi Doug. Have you had a chance to look at these materials?

Steve

Steven B. Phillips
Attorney at Law
Registered Patent Attorney
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P.O. Box 13706
Research Triangle Park, NC 27709-3706
Direct Dial: 919-286-8124 Direct Fax: 919-416-8324
Switchboard: 919-286-8000 Main Fax: 919-286-8199
<http://www.mvalaw.com>

From: Steven Phillips
Sent: Tuesday, September 23, 2008 8:14 AM
To: 'Doug'
Subject: RE: Viewpointe Declaration of Prior Conception and Due Diligence

Doug,

This type of document can only be used if the inventors sign. Under the regulations, we have to try to get as many inventors to sign as possible. If you are inclined to help, but have concerns about liability, you need to take that up with your own legal counsel or possibly an insurance company. The fact that this is related to legal obligations connected with your Viewpointe employment might possibly be relevant to such liability, what insurance would cover, etc., thus, I cannot advise you specifically since Viewpointe is my client.

I can certainly sympathize with your "give a darn" level. My experience however has been that most inventors are proud to have their name on a patent, and so are willing to provide such small assistance. I submitted an invention disclosure when I was an engineer and I have always regretted that the company didn't pursue it. I know a number of patent attorneys who have also been inventors and I have always been envious of them.

Please let me know what you want to do, and please understand that, again, since Viewpointe is my client, I will inform them of our discussion. It is OK if it takes you a week or two to get to this.

Best regards,

Steve

Steven B. Phillips
Attorney at Law

2/9/2009

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From: Doug [mailto:Douglasgsmith@bellsouth.net]
Sent: Saturday, September 20, 2008 9:35 PM
To: Steven Phillips
Subject: RE: Viewpointe Declaration of Prior Conception and Due Diligence

Steve,

I going out of town tomorrow morning and won't have time to look at this for a week or so.

I'm also wondering if I should even sign this at all. Viewpointe certainly isn't covering me with liability insurance anymore and I no longer carry any professional liability insurance of my own. Besides, I've been retired over two years and my "give a darn" level about this patent is very, very low.

Doug Smith
864-244-6374

-----Original Message-----

From: Steven Phillips [mailto:stevenphillips@mvalaw.com]
Sent: Friday, September 19, 2008 9:50 AM
To: DouglasGSmith@bellsouth.net
Cc: stephen.lapham@viewpointe.com
Subject: Viewpointe Declaration of Prior Conception and Due Diligence

Hi Doug,

I believe Steve Lapham has been in touch with you regarding this. I am working on a Declaration of facts to file in the U.S. Patent and Trademark Office as part of trying to get the image share patent application issued. The Declaration supports the position that the invention was conceived prior to the date of some of the prior art the Examiner is using, and further that a patent application was prepared with due diligence. I wanted to send you an advance copy for your comments, and also obtain your full contact information, as we need you, as an inventor, so sign the Declaration.

I have attached both a draft of the Declaration with attachments, which have some information blocked out, as well as an extra copy of the attachments, with all the information left in tact, since you need to understand what you are declaring. I am relatively certain this is all accurate and fine, except for the part about the Invention Disclosure Form. Please review all of it, but especially the part about the Invention Disclosure Form, which appears in paragraph 2 of the Declaration. My understanding is that Paul Abbott prepared this originally and Jerry Chambers marked it up, both with input from your and/or Pat. I have also included in the extra copy of the attachments an Email I found which seems to support this. Notice this and other statements in the Declaration are qualified by the phrase, "on information and belief" which means you may not have first-hand knowledge of the fact, but it seems accurate based on the impressions you have gotten from others. If you find errors or other problems in the Declaration, please contact me as soon as possible so that we may discuss the matter, since in signing this, you are making a statement to a government agency that is treated for all intents and purposes as a statement under oath. In addition to the materials mentioned above, I have included a copy of our published patent application, which lists the filing date for the provisional patent application, so you can verify that date, which is mentioned in the Declaration.

Please let me know your thoughts. Return Email is fine, but you may also call if you like. Once you are comfortable with this I may touch base with Pat, then send you a final, clean, copy to sign and return.

Steve

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